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09/429,585	10/28/1999	THOMAS J. SHAFRON	694231/002	6107

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STROOCK & STROOCK & LAVAN LLP
180 MAIDEN LANE
NEW YORK, NY 10039

EXAMINER

DETWILER, BRIAN J

13

ART UNIT

PAPER NUMBER

2173

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12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/429,585

Applicant(s)

SHAFRON, THOMAS J.

Examiner

Brian J Detwiler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-68 and 77-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53-68 and 77-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 61-63 and 66 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by U.S. Patent No. 6,282,548 (Burner et al).

Referring to claim 61, Burner discloses in Figure 4 an Internet browser interface displayable on the display of a computer, inherently enabling a user to access and navigate web pages from a plurality of Internet sites. Figure 4 further shows an Internet browser toolbar comprising a "Home" button programmed to cause the browser to display a predetermined Internet site. Figure 4 still further shows a user toolbar [405]. Said user toolbar [405], according to column 7: lines 63-67 and column 8: lines 1-7, is preferably displayed concurrently with a web page, but is not part of the displayed web page. Burner explains in this section that the toolbar could alternately be implemented as an extension of the browser or as browser plug-in software. In such an instance, the user toolbar could be displayed along with the Internet browser toolbar while the browser is activated regardless of the Internet site to which the computer is connected.

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Referring to claims 62 and 63, Burner discloses several toolbar buttons [450, 452, 454] in the user toolbar [405] illustrated in Figure 4. In column 13: lines 36-67 and column 14: lines 1-21, Burner explains that the toolbar is customizable by using the popup menu [1000] to add specific links.

Referring to claim 66, Burner explains in column 8: lines 5-7 that the toolbar software can be implemented as "plug-in" software. Accordingly, the toolbar's interface objects are plug-in controls that can be used to customize the interface as mentioned above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 53, 54, 56, 57, 77-79, 81, 82, 84, and 85 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,282,548 (Burner et al) and the Alexa Internet Web Site.

Referring to claims 53, 77, and 84, Burner discloses in Figure 4 an Internet browser interface displayable on the display of a computer, inherently enabling a user to access and navigate web pages from a plurality of Internet sites. Figure 4 further shows an Internet browser toolbar comprising a "Home" button programmed to cause the browser to display a predetermined Internet site. Figure 4 still further shows a user toolbar [405]. Said user toolbar

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[405], according to column 7: lines 63-67 and column 8: lines 1-7, is preferably displayed concurrently with a web page. Burner adds that the toolbar is not part of the displayed web page, but rather controlled by separate client software. In column 8: lines 48-67 and column 9: lines 1-9, Burner provides details on the additional functionality that is provide to the browser interface regardless of the Internet site to which the computer is connected. Although Burner's invention is recognized as separate client software, the reference fails to disclose providing access to the software at a predetermined Internet site and making the software available for download by the user. The Alexa Internet Web Site, however, offers users access to specific software for adding a user toolbar to their Internet browser interfaces. The Alexa Internet Web Site further provides a direct link for downloading the software to the user's computer. Relating specifically to claims 77 and 84, the Alexa Internet Web Site inherently operates on a server. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make Burner's software available for download at an Internet web site as suggested by the Alexa Internet Web Site. Alexa claims to offer a free, ad-supported, Web navigation service, and therefore relies on the distribution of their product to Internet users. Furthermore, Alexa suggests through such a business model that making their product available for download at a predetermined Internet site is a feasible mechanism for successfully distributing their software. Therefore, it would have been beneficial for Burner to adopt Alexa's teachings to harvest monetary gains from his invention.

Referring to claims 54, 57, 78, 79, and 82, Burner discloses several toolbar buttons [450, 452, 454] in the user toolbar [405] illustrated in Figure 4. In column 13: lines 36-67 and column

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14: lines 1-21, Burner explains that the toolbar is customizable by using the popup menu [1000] to add specific links.

Referring to claims 56 and 81, Burner explains in column 8: lines 5-7 that the toolbar software can be implemented as "plug-in" software. Accordingly, the toolbar's interface objects are plug-in controls that can be used to customize the interface as mentioned above.

Referring to claim 85, the examiner took Official Notice in a previous office action to state that is well known in the state of the art that configuration, preference, or initialization files can be opened upon activation of an Internet browser and instruct the browser to load a predetermined home page. Applicant did not traverse the taking of Official Notice in response to that action. Accordingly, the officially noticed fact is admitted as prior art and suggests that the process of a user manually entering a URL can be automated as a form of user convenience. Burner's invention, as illustrated in Figure 3, indicates that a user must in fact enter a URL in the traditional fashion before the toolbar operated by the client software can define the interface objects. It would have been obvious to one of ordinary skill in the art at the time the invention was made, however, to automate this procedure as indicated in the officially noticed fact. Such a combination would conveniently allow a user to start navigating the Internet in a less time-consuming manner.

Claims 55 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,282,548 (Burner et al) and the Alexa Internet Web Site as applied to claims 53 and 77 above, and further in view of U.S. Patent No. 6,292,185 (Ko et al).

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Burner discloses in column 8: lines 23-39 that his invention could be implemented using JavaScript as well as any other programming languages or plug-ins that are supported by the browser. Accordingly, the Burner reference suggests that any suitable technology could be used and not stray from the intentions of the invention. Burner does not specifically disclose utilizing ActiveX controls for customizing the user toolbar, but Ko teaches in column 7: lines 23-33 using ActiveX controls to customize browser interfaces. Since Ko teaches that it is known to customize browser interfaces with ActiveX controls, and Burner specifically discloses using JavaScript, which can be used to program ActiveX controls, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Burner and Ko. It would have been advantageous for Burner to use ActiveX controls because they can be programmed using almost any major scripting language and they are compatible with popular web browsers such as Microsoft Internet Explorer and Netscape Navigator.

Claims 58 and 83 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,282,548 (Burner et al) and the Alexa Internet Web Site as applied to claims 54 and 79 above, and further in view of Using Microsoft Internet Explorer 4:

Burner and the Alexa Internet Web Site fail to disclose a search window as part of a user toolbar. The Internet Explorer reference however, discloses in Figure 3.11 on page 42 an entire browser toolbar dedicated to searching at a predetermined Internet site regardless of the site to which the browser is connected. Thus, the Internet Explorer reference suggests that it is desirable to have a separate search window, which can remain open at all times, that allows a user to initiate a search at a predetermined Internet site. Accordingly, it would have been

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obvious to one of ordinary skill in the art at the time the invention was made to add a search window to the user toolbar disclosed by Burner and Alexa so that users do not have to manually navigate to a search engine Internet site each time that they wish to perform a search.

Claims 59 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,282,548 (Burner et al) and the Alexa Internet Web Site as applied to claim 53 above, and further in view of U.S. Patent No. 6,020,884 (MacNaughton et al).

The Burner reference and the Alexa Internet Web Site fail to disclose storing user-specific information for defining the contents of a toolbar. MacNaughton, however, discloses in column 10: lines 41-48 a toolbar operating as an interface extension to an Internet browser. According to columns 9 and 10, profile information is stored for each user, which is used to populate the toolbar with special controls needed to interact in various online communities. MacNaughton explains in column 9: lines 11-19 that users can have different profiles for each community that they belong to. By storing user specific information, MacNaughton's invention saves the users from having to reenter profile data each time they visit a community. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of MacNaughton with the Burner reference and the Alexa Internet Web Site so that data specific to a user at a particular web site does not have to be reentered each time the user returns to the web site.

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Claim 64 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,282,548 (Burner et al) as applied to claim 62 above, and further in view of Using Microsoft Internet Explorer 4.

The claim is rejected for the same reasons applied to claims 58 and 83 above, except that the Alexa Internet Web Site is not required as a reference.

Claim 65 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,282,548 (Burner et al) as applied to claim 62 above, and further in view of U.S. Patent No. 6,292,185 (Ko et al).

The claim is rejected for the same reasons applied to claims 55 and 80 above, except that the Alexa Internet Web Site is not required as a reference.

Claim 67 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,282,548 (Burner et al) as applied to claim 62 above, and further in view of U.S. Patent No. 6,020,884 (MacNaughton et al).

For the reasons applied to claims 59 and 60 above, it would have been obvious to store user-specific information at a predetermined Internet site. Using the officially noticed fact and the provided explanation applied to claim 85 above, it also would have been obvious to establish a connection to the predetermined Internet site when the Internet browser is first activated. Accordingly, the claim is rejected on grounds previously established.

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Claim 68 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,282,548 (Burner et al) and U.S. Patent No. 6,020,884 (MacNaughton et al) as applied to claim 67 above, and further in view of U.S. Patent No. 6,119,098 (Guyot et al).

Burner and MacNaughton fail to disclose periodically reconnecting to a predetermined Internet site. Guyot, however, discloses in column 1: lines 55-67 and column 2: lines 1-8 an application that periodically accesses a predetermined Internet site to download user-specific advertisements for display in the application interface illustrated in Figures 4A and B. Accordingly, the Guyot reference suggests that it is well known to periodically reconnect to an Internet server to download the most recent information and apply it to an application interface. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Guyot with those of Burner and MacNaughton so as to ensure that a dynamic browser interface, like the one disclosed by Burner, maintains up-to-date and relevant information.

Claim 86 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,282,548 (Burner et al) and the Alexa Internet Web Site as applied to claim 85 above, and further in view of U.S. Patent No. 6,119,098 (Guyot et al).

For the reasons applied to claim 68 above, it would have been obvious to combine the teachings of Guyot with those of Burner and the Alexa Internet Web Site so that Burner's user toolbar would periodically reconnect to a predetermined Internet site to download the most up-to-date and relevant information.

Response to Arguments

Applicant's arguments filed 3 March 2003 have been fully considered but they are not persuasive. Applicant essentially makes three arguments that are repeated multiple times throughout the response. First, Applicant asserts that references fail to teach a toolbar that is displayed as part of an Internet browser and comprises additional functionality that was not a part of the Internet browser prior to downloading the toolbar software. Applicant heavily relies on the assertion that Burner only discloses a toolbar that is separate and distinct from the browser. While it is certainly true that Burner's primary embodiment and illustrations disclose the toolbar as being a separate entity, Burner specifically points out in column 8: lines 5-7 that in an alternative embodiment, "the present invention may be implemented as an extension of the browser or as browser "plug-in" software." Furthermore, Burner discloses in the abstract that the invention includes the additional functionality of gathering metadata from a database metadata server about a web page displayed by the Internet browser. Accordingly, Burner clearly discloses the limitations in question and thus the rejections involving Burner are proper.

Second, in response to applicant's argument that there is no teaching or suggestion to combine the various references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In the combinations disclosed above, the examiner properly

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provides motivations based on said general knowledge. Since Applicant does not address any of the motivations specifically, no further explanation is believed to be necessary.

Third, in response to applicant's argument that the examiner's conclusions of obviousness are based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Again, Applicant does not address any specific matters of obviousness directly, and therefore the examiner can only respond generally to the blanket statement that the combinations "involve impermissible hindsight reconstruction of the invention involving 'picking and choosing' from the teachings of that art."

Applicant further asserts that claims 67 and 85 do not behave in the manner interpreted by the examiner. Applicant is reminded that Office personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. In *re Morris*, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997). Limitations appearing in the specification but not recited in the claim are not read into the claim. In *re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-551 (CCPA 1969). See also *In re Zletz*, 893 F.2d 319, 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989) ("During patent examination the pending claims must be interpreted as broadly as their terms reasonably allow.... The reason is simply that during patent prosecution when claims can be amended, ambiguities should be recognized, scope and breadth of language explored, and clarification imposed.... An essential purpose of patent examination is to fashion

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claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed, as much as possible, during the administrative process.”). Accordingly, a mere allegation that the examiner misinterpreted a claim is not substantial enough to warrant new grounds of rejection.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein provide further support of the toolbar browser accessory developed by Alexa Internet.

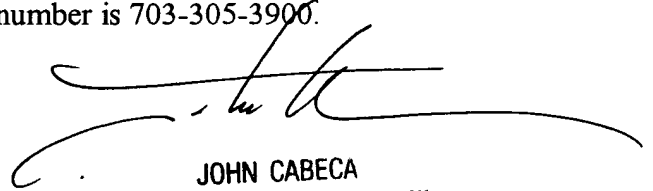
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J Detwiler whose telephone number is 703-305-3986. The examiner can normally be reached on Mon-Thu 8-5:30 and alternating Fridays 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W Cabeca can be reached on 703-308-3116. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

bjd
April 22, 2003



JOHN CABECA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER